



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,905	12/14/2001	Paul M. Ridker	B0801/7238 (ERG/KA)	7653
7590 06/30/2010				
Edward R. Gates Wolf, Greenfield & Sacks, P.C. Federal Reserve Plaza 600 Atlantic Avenue Boston, MA 02210				
EXAMINER				
EWOLDT, GERALD R				
ART UNIT		PAPER NUMBER		
1644				
MAIL DATE		DELIVERY MODE		
06/30/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/017,905

Applicant(s)

RIDKER ET AL.

Examiner

G. R. Ewoldt, Ph.D.

Art Unit

1644

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,11,16,21,52,55,57,62-68 and 71-75 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,6,11,16,21,52,55,57,62-68 and 71-75 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/1/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed 6/01/10 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment, remarks, and IDS filed 6/01/10 have been entered.

2. Claims 1, 6, 11, 16, 21, 52, 55, 57, 62-68, and 71-75 are being acted upon.

3. In view of Applicant's amendments now limiting the claimed method to employing individuals free of diabetes, the previous rejections under 35 U.S.C. 103(a) have been withdrawn.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 6, 16, 21, 52, 55, 57, 62-68, and 71-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Ford (1999).

Ford teaches obtaining levels of C-reactive in a blood sample from a patient free of diabetes (See particularly Tables 1 and 2: Table 1 shows C-reactive levels and Table 2 shows that some individuals had no diabetes). Note that the new "predicting" limitation of the claims is clearly a mental step that does not separate the claimed method from the method of the prior art. Regarding the levels of C reactive protein, i.e., about 0.30 mg/dl and about 0.60 mg/dl, these limitations add no

Art Unit: 1644

patentability to the claims because they are not actually used or compared in any active method steps.

Applicant's arguments, filed 6/01/10, have been fully considered but are not found persuasive. Applicant argues that the prior art does not teach every element of the amended claims.

As set forth in the rejection, the amendments to the claims have added no actual method steps. Accordingly, the rejection has been maintained.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 11 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, specifically:

As set forth previously, it is unclear whether or not the "comparing" of the claim is actually a step or not. As set forth in MPEP 608.01(m), each step of a claim must be indented. The possible "comparing" step of Claim 11 is not indented.

Applicant has not addressed this issue.

8. The following are new grounds for rejection.

9. Claims 21, 55, 62, 68, and 71-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Connolly et al. (1988).

Connolly et al. teaches obtaining levels of C-reactive protein in a blood sample from a patient free of diabetes (See particularly MEASUREMENT OF PLASMA PROTEINS, page 517). The reference further teaches the predicting that the patient would benefit from the administration of the anti-inflammatory auranofin. The benefit for the reducing of diabetes or a diabetic complication is an inherent property of the method.

The reference clearly anticipates the claimed invention.

Art Unit: 1644

10. No claim is allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (571) 272-0843. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ram Shukla, can be reached on (571) 272-0878.

12. **Please Note:** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/G.R. Ewoldt/
G.R. Ewoldt, Ph.D.
Primary Examiner
Technology Center 1600